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Mark N. Robins et al.
Atty Dkt 10015542-1

REMARKS

Claims 1-20 were pending in the application prior to this response. Claims 1 and 14 have been amended herein. Claims 2, 6, 7, 9, 10 and 17-20 have been canceled. Claims 3-5, 8, 11-13, 15 and 16 remain in the application unchanged. New claim 21 has been added. Accordingly, after entry of this amendment, claims 1, 3-5, 8, 11-16 and 21 will be pending in the application. Reexamination and reconsideration are requested.

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I. Legal Basis for Prior Art Claim Rejections Made in the Office Action

Legal Basis for Claim Rejection Under 35 U.S.C. §102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986).

Obviousness Under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the Claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972).

In the case of *In re Wright*, 6 USPQ 2d 1959 (CAFC 1988), the CAFC decided that the Patent Office had improperly combined references which did not suggest the properties and results of the applicants' invention nor suggest the claimed combination as a solution to the problem which applicants'

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invention solved.

The CCPA reached this conclusion after an analysis of the prior case law, at p. 1961:

We repeat the mandate of 35 U.S.C. 103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the invention is directed"), quoting *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); *In re Antonie*, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., *In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on the product created, rather than on the obviousness or notoriety of its creation") (quoting *General Motors Corp. v. U.S. Int'l Trade Comm'n*, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. *Rinehart*, 531 F.2d at 1054, 189 USPQ at 149; see also *In re Benno*, 768 F.2d 1340, 1345, 226 USPQ 683, 687 (Fed. Cir. 1985) ("appellant's problem" and the prior art present different problems requiring different solutions").

A basic mandate inherent in Section 103 is that a piecemeal

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reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972). Phrased somewhat differently, the fact that inventions of the references and of applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. *In re Donovan*, 184 USPQ 414, 420 (CCPA 1975).

It is also clearly established in the case law that a change in the mode of operation of a device which renders that device inoperative for its stated utility as set forth in the cited reference renders the reference improper for use to support an obviousness-type rejection predicated on such a change. See, e.g., *Diamond International Corp. v. Walterhoefer*, 289 F.Supp. 550, 159 USPQ 452, 460-61 (D.Md. 1968); *Ex parte Weber*, 154 USPQ 491, 492 (Bd.App. 1967). In addition, any attempt to combine the teaching of one reference with that of another in such a manner as to render the invention of the first reference inoperative is not permissible. See, e.g., *Ex parte Hartmann*, 186 USPQ 366 (Bd.App. 1974); and *Ex parte Sternau*, 155 USPQ 733 (Bd.App. 1967).

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. 103 rejection of applicants' claims. See *United States v. Adams*, 148 USPQ 429 (Sup. Ct. 1966).

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II. Rejection of Claims 1, 3-8 and 13 under 35 U.S.C. §102(e)

Claims 1, 3-8 and 14 stand rejected under 35 U.S.C. §102(e) as being anticipated by Okuda (U.S. Publication No. 2004/0165108). Reexamination and reconsideration of the Examiner's rejection are requested.

Applicants' Claim 1, as amended herein, recites the following:

An image capturing device, comprising:
a display screen integrally formed on a surface of said image capturing device;
a cover capable of being positioned over said display screen and capable of being retracted away from said display screen; and
a guide device that retains said cover against said surface of said image capturing device;
wherein said cover comprises a segmented cover including a plurality of vertical segments, with said plurality of vertical segments being flexibly joined to each other; and
wherein said guide device comprises a pair of partially curved tracks formed as part of an exterior surface of said image capturing device, with said exterior surface including a curved portion and wherein said cover moves along said exterior surface.

Claim 1 has been amended herein, as indicated above, to include the limitations of dependent claims 2 and 9; claims 2 and 9 have been canceled.

Since claims 2 and 9 are not rejected as being anticipated by Okuda, the inclusion of the subject matter of these claims into base claim 1 is believed to overcome the current rejection of claim 1. It is noted, however, that claims 2 and 9 stand rejected under 35 U.S.C. §103(a) as being

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unpatentable over Okuda in view of Yamagata (U.S. Patent 6,003,052).
Accordingly, applicants respond to this rejection as follows.

Claim 1 recites the following (this language previously appearing in dependent claim 9):

wherein said guide device comprises a pair of partially curved tracks formed as part of an exterior surface of said image capturing device, with said exterior surface including a curved portion and wherein said cover moves along said exterior surface.

The Examiner discusses this limitation as follows:

Regarding claim 9, Okuda discloses the use of a camera ... with a display cover (4) along the exterior surface ... but does not teach partially curved tracks where a cover can move along the curved portion of the tracks. Yamagata teaches a portable information instrument (1) having curved tracks where a cover (3) can move along the curved portion of the tracks **inside the device** Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the partially curved tracks where a cover can move along the curved portion of the tracks of the device as disclosed by Yamagata. One would have been motivated to make such a modification in view of the suggestion in Yamagata that partially curved tracks where a cover can move along the curved portion of the tracks of the device for a camera so that the display cover can be accommodated into a limited space **within the housing**

(Office action, Section 4., page 4, first full paragraph, emphasis added)

As correctly pointed out by the Examiner, Yamagata discloses a cover that moves along a curved path *inside the device* (see, e.g., Fig. 1B of Yamagata). Accordingly, a combination of the Okuda and Yamagata references might suggest, at best, a camera having a cover that moves along

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a curved path *inside the camera*. Applicants' claim 1, however, recites "a pair of partially curved tracks *formed as part of an exterior surface of said image capturing device*" (italics added). Thus, all of the limitations of claim 1, as amended, are not met even by the Examiner's proposed combination of references.

Applicants further respectfully assert that the rejection is improper because there is no motivation to combine the Okuda and Yamagata references, as proposed by the Examiner. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Clr. 1997).

For at least the reasons advanced above, applicants respectfully assert that a *prima facie* case of obviousness has not been established; therefore, claim 1, as amended, should be allowed.

Claims 3-5, 8 and 13 are allowable at least as ultimately depending from allowable base claim 1. Claims 6 and 7 have been canceled.

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III. Rejection of Claims 2, 9-12 and 14-20 Under 35 U.S.C. §103(a)

Claims 2, 9-12 and 14-20 stand under 35 U.S.C. §103(a) as being unpatentable over Okuda (U.S. Publication No. 2004/0165108) in view of Yamagata (U.S. Patent 6,003,052). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 2 and 9-12

Claims 11 and 12 are allowable at least as ultimately depending from allowable base claim 1. Claims 11 and 12 are allowable on further independent grounds because there is no motivation to combine the Okuda and Yamagata references, as discussed previously in this response. Claims 2, 9 and 10 have been canceled.

Claims 14-20

Claim 14, as amended herein, recites the following:

A cover adapted for use with a display screen of an image capturing device, comprising: a segmented cover capable of being manually positioned over said display screen and capable of being manually retracted away from said display screen; a guide device that retains said segmented cover against a back surface of said image capturing device; and a protrusion formed on said segmented cover;
wherein said guide device comprises a pair of partially curved tracks formed as part of an exterior surface of said image capturing device, with said exterior surface including a curved portion and

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wherein said segmented cover moves along said exterior surface.

Claim 14 has been amended herein, as indicated above, to include the limitations of dependent claim 19; claim 19 has been canceled.

Claim 14, thus, now recites a "pair of partially curved tracks formed as part of an exterior surface of said image capturing device". Accordingly, claim 14 is allowable for at least the reasons advanced above with respect to the rejection of claim 1.

Claims 15 and 16 are allowable at least as ultimately depending from allowable base claim 14. Claims 17-20 have been canceled.

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IV. New Claim 21

New independent claim 21 has been added herein and recites the following:

A method comprising:

providing an image capturing device comprising:

- a display screen formed on a surface of said image capturing device;
- a cover capable of moving between a first closed condition in which said cover is positioned over said display screen and a second retracted condition in which said cover is not positioned over said display screen, said cover comprising at least a first cover portion and a second cover portion; and
- a guide device that retains said cover against said surface of said image capturing device;

causing said first cover portion to move in a first direction by moving said second cover portion in a second direction, opposite said first direction and thereby moving said cover from said first closed condition to said second retracted condition.

New claim 21 is fully supported by the application as originally filed with reference, for example, to drawing Fig. 4 and to the written specification at pages 7-8, paragraph [0027]. No new matter has been added.

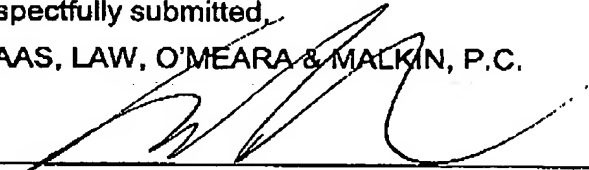
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In view of the above, all of the claims are now believed to be in
condition for allowance. Re-examination and reconsideration are requested.

Respectfully submitted,

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